

REMARKS

I. Introduction

With the addition of new claims 27 to 29, claims 10 to 29 are currently pending in the present application. In view of the foregoing amendments and the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration of the present application is respectfully requested.

II. Rejection of Claims 10 and 24 Under 35 U.S.C. § 102(b)

Claims 10 and 24 were rejected under 35 U.S.C. § 102(b) as anticipated by European Published Patent Application No. 0 657 698 ("Kawamura"). Applicants respectfully submit that Kawamura does not anticipate the present claims for the following reasons.

Claim 10 relates to a glow plug that has a heating element and a switch for controlling a heating current for the heating element, where the heating current is controlled by **opening and closing the switch**. Kawamura discusses a current control means, the resistance of which sharply increases above a specified temperature. According to Kawamura, when the temperature rises above a certain threshold temperature, current flow is reduced by increased resistance of the current control means 10. However, the increase of resistance to reduce current flow does not constitute a switch within the context of the present claims, and the description by Kawamura of increasing resistance in a current control means does not constitute a disclosure, or even a suggestion, of "a switch positioned in [a] region of [a] current feed-through, wherein . . . heating current is adapted to be controlled by opening and closing the switch" as recited in claim 10.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. Verdegaal Bros. v. Union Oil Co. of Calif., 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the . . . claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). As more fully set forth above, it is respectfully submitted that

Kawamura does not disclose, or even suggest, all of the limitations of claim 10. It is therefore respectfully submitted that Kawamura does not anticipate claim 10.

As for claim 24 which ultimately depends from claim 10 and therefore includes all the limitations of claim 10, it is respectfully submitted that Kawamura does not anticipate claim 24 for at least the same reasons given above in support of the patentability of claim 10.

In view of the foregoing, withdrawal of this rejection is respectfully requested.

III. Rejection of Claim 11 to 23, 25 and 26 Under 35 U.S.C. § 103(a)

Claims 11 to 23, 25 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combination of Kawamura, U.S. Patent No. 6,150,634 ("Haussner et al."), and U.S. Patent No. 4,598,676 ("Ito et al."). It is respectfully submitted that the combination of Kawamura, Haussner et al., and Ito et al. does not render unpatentable claims 11 to 23, 25, and 26 for the following reasons.

As an initial matter, as indicated in the Amendment filed on January 14, 2004, U.S. Patent No. 6,150,634 issued on **November 21, 2000** from U.S. Patent Application Serial No. 09/440,265, filed on **November 15, 1999**. The **November 15, 1999** filing date of U.S. Patent No. 6,150,634 is **after** the **September 15, 1999** filing date of German Application No. 199 44 193.6, from which the present application claims priority. A certified English-language translation of German Application No. 199 44 193.6 was submitted with the Amendment filed on January 14, 2004. In view of the foregoing, it is respectfully submitted that U.S. Patent No. 6,150,634 does not constitute prior art against the present application. Accordingly, withdrawal of the present rejection is respectfully requested.

IV. New Claims 27 to 29

New claims 27 to 29 have been added herein. It is respectfully submitted that new claims 27 to 29 do not add any new matter and are fully supported by the present application, including the Specification.

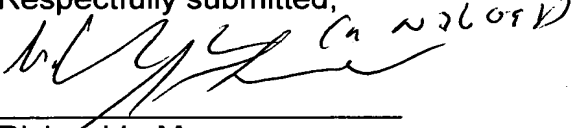
Since claims 27 and 28 depend from claim 10, it is respectfully submitted that claims 27 and 28 are patentable over the references relied upon for at least the same reasons given above in support of the patentability of claim 10.

Since claim 29 depends from claim 25, it is respectfully submitted that claim 29 is patentable over the references relied upon for at least the same reasons given above in support of the patentability of claim 25.

V. Conclusion

In light of the foregoing, it is respectfully submitted that all pending claims are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Dated: 13 May, 2004

Respectfully submitted,

By: _____
Richard L. Mayer
Reg. No. 22,490
KENYON & KENYON
One Broadway
New York, New York 10004
(212) 425-7200
CUSTOMER NO 26646